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REMARKS

By this amendment, Applicant amends claims 19, 20, 23, 24, 26, 29–32, 35–48, 51–56, and 58–60 to set forth the invention with more particularity. No new matter is added by this amendment. Claims remaining in this application are:

Independent claims: 19, 29, 45

Dependent claims: 20–28, 30–44, 46–60

Rejections under 35 U.S.C. § 103

As summarized in the prior amendment and response, Applicant's claims are directed to a gaming method and device in which a bonus selection apparatus displays changeable bonus award amounts. These changeable bonus award amounts may be changed between base games or during the course of a base game. For example, in one optional embodiment, changeable bonus award amounts, such as 100, 500, and 750 coins, may initially be shown on a bonus selection apparatus. However, as the player increases the player's wager on the base game, the changeable bonus award amounts shown on the bonus selection apparatus may change to 350, 2500, and 3500 coins. As discussed in the specification, these bonus award amounts may change in response to any number of conditions, including those under the player's control, such as the wager amount, number of pay lines activated, the number of coins wagered on each pay line, or the like, or those outside of the player's control, such as the outcome of the base game or a random event.

In addition to displaying the changeable bonus award amounts, the bonus selection apparatus also selects a bonus award amount upon the occurrence of a bonus trigger condition.

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Thus, the display of a changeable bonus award amount on the bonus selection apparatus does not guarantee that it will be selected and awarded since (1) the bonus selection apparatus may display more than one changeable bonus award available for selection and (2) a changeable bonus award is only issued if it is selected after a bonus trigger condition. As discussed in the specification, the bonus trigger condition may relate to the base game or may be independent of the base game.

In the office action of July 7, 2009, Examiner suggested that Applicant's claims did not clearly define the "changeable" nature of the bonus awards in Applicant's game. While Applicant feels that the changeability of the bonus awards were sufficiently described in the claims as previously submitted, Applicant has amended the claims to specifically identify the bonus awards as "changeable." Support for this amendment appears in the specification in the paragraph beginning at page 6, line 13 and in the Abstract, as well as claim 1 as originally filed.

Since Examiner did not interpret the claims to include changeable bonuses, Examiner did not cite any reference as disclosing or suggesting changeable bonuses. Applicant submits that neither Demar nor Adams discloses the features recited in the claims. Demar, for example, discloses a game in which a second display is used to conduct a bonus game that is triggered by "some event, or sequence of outcomes which occur at a low frequency" in the "basic game." Demar, col. 4, ll. 12–14. The bonus game is a spin-until-you-lose game in that the player is awarded "another play or trial" until "a losing trial occurs." *Id.* at col. 4, ll. 26–28.

To recapitulate the arguments presented in the prior response, Demar discloses a number of embodiments, but generally discloses a bonus game in which bonus reels containing bonus symbols are spun at least once to determine the player's bonus award. While Demar discloses

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that the bonus symbols appearing on the bonus reels may differ from the symbols appearing on the basic game reels, Demar fails to disclose or suggest *changeable* bonus symbols. Put another way, in the example described in Demar at column 6, lines 20–39, a symbol set for a basic game may include Triple Bar, Double Bar, Single Bar, and Cherry reel symbols, and a symbol set for a bonus game may add a Red 7 and Blue 7 to the basic game set. However, Demar does not disclose or suggest that the Red 7 may, for example, change to a White 7 during the course of a game or between games as recited in the amended claims. In short, Applicant discloses a bonus selection apparatus that is dynamic in two respects — the bonus selection apparatus moves or simulates motion to select a bonus award amount *and the bonus award amounts displayed on the bonus selection apparatus can change even when the bonus selection apparatus is stationary.* Demar, by contrast, only discloses a *static, unchanging* bonus set (e.g. *id.* at col. 6, ll. 27–29 which fixes the symbols in the bonus set and FIG. 3 which fixes the number of symbols on each reel).

Moreover, Demar fails to show changeable pay outs in the bonus game. As illustrated in FIG. 3 of Demar, the bonus pay schedule is fixed regardless of, for example, the triggering condition or other game event. This differs from Applicant's claims in which the bonus award *amounts* are specifically described as "changeable." Demar fails to disclose or suggest that the award amounts can be changed. While Examiner may point to Demar's suggestion that the bonus pay table may differ from the basic pay table, Applicant submits that even if the bonus pay table may differ from the basic pay table, the bonus pay table itself is fixed in Demar. Specifically, Demar never discloses or suggests that the bonus pay outs could change from spin

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to spin or game to game as recited in Applicant's claims.

Although Examiner did not cite Adams as disclosing such features, Applicant submits that such features cannot be found in Adams either. Adams discloses a wheel from which a bonus award is selected. The wheel disclosed in Adams has fixed bonus indicia and nowhere does Adams suggest that the bonus indicia may change.

Applicant further submits that the features cannot be found by combining Adams and Demar. As Examiner is well aware, Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. Significantly, the prior art reference (or references when combined) must teach or suggest *all* the claimed limitations. MPEP § 2143. Since neither Demar nor Adams disclose changeable bonus award amounts on a bonus selection apparatus, Applicant submits that a prima facie case of obviousness cannot be supported.

To the extent, however, that Examiner believes that such a feature is obvious, Applicant submits that Examiner has not explicitly explained the rationale as required under *KSR International Co. v. Teleflex Inc.* and the related sections of the MPEP. While *KSR* may have relaxed or removed the requirement of finding an explicit motivation or suggestion for a proposed combination or modification, *KSR* did *not* relax or remove the requirement that each and every element be found in the prior art. To the contrary, the Supreme Court in *KSR* specifically held that "it will [often] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the *known*

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elements in the fashion claimed by the patent at issue” and that “to facilitate review, this analysis should be made explicit.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___ (2007) (emphasis added). Two conclusions can be drawn from this statement in *KSR*. First, even if the Examiner is permitted latitude in looking for the *reasons* to combine or modify elements, all the elements must still be *known*. This is expanded upon in the Manual of Patent Examining Procedure which explicitly states that all claim limitations must be considered in an obviousness analysis. *See MPEP § 2143.03*. Second, the Examiner must explicitly provide the reasoning for stating that a particular feature is known and how that known feature can be modified or combined “in the fashion claimed by the patent at issue.”

For these reasons, Applicant submits that independent claims 19, 29, and 45, which all include claim limitations directed to changeable bonus award amounts, distinguish over Demar, alone or in combination with Adams. Thus, Applicant respectfully submits that claims 19, 29, and 45 are in condition for allowance.

Dependent claims 20–22 recite various embodiments of the bonus award selector. Since these claims depend from allowable claim 19, Applicant submits that these claims are in condition for allowance.

Dependent claim 23 recites an embodiment in which the changeable bonus award amount is selected randomly. Because this claim depends from allowable claim 19, Applicant submits that this claim is in condition for allowance.

Dependent claims 24 and 25 recite an embodiment in which the changeable bonus award amount selected for display on the bonus selection apparatus is changed during a base game.

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That is, in such an embodiment, the computer processor conducts the base game and, during that conduct, selects a changeable bonus award amount to be displayed at the bonus selection apparatus. Additionally, claim 25 recites an embodiment in which the bonus selection apparatus is updated to display the selected changeable bonus award amount during the course of a base game. Demar and Adams fail to disclose or suggest the selection of a changeable bonus award amount for display on a bonus selection apparatus, let alone making that selection during a game. Additionally, Demar and Adams fail to disclose or suggest changing the display of a bonus award amount, let alone changing the display of a bonus award amount during a game. For these reasons, and because claims 24 and 25 depend from allowable claim 19, Applicant submits that claims 24 and 25 are allowable.

Dependent claim 26 recites an embodiment in which the changeable bonus award amount selected for display on the bonus selection apparatus is changed between base games. Additionally, claim 27 recites an embodiment in which the bonus selection apparatus is updated to display the selected bonus award amount between base games and claim 28 recites an embodiment in which the update is delayed so that the bonus selection apparatus is updated to display the selected changeable bonus award amount during the course of a base game. As above, Demar and Adams fail to disclose or suggest either selecting a changeable bonus award amount for display on a bonus selection apparatus or changing the display of a bonus award amount. Consequently, they fail to disclose or suggest the specific sequence of selection and display recited in claims 26–28. For these reasons, and because claims 26–28 depend from allowable claim 19, Applicant submits that claims 26–28 are allowable.

Independent claim 29 was addressed above in combination with independent claims 19 and 45. For the reasons advanced above, Applicant submits that claim 29 is allowable.

Dependent claim 30 depends from claim 29 and recites that the selection of the changeable bonus award amount to be displayed on the bonus selection apparatus depends, at least in part, on the number of pay lines activated in the base game. Demar and Adams fail to disclose changing any feature of their respective second games based on the player's conduct of the base game. More specifically, Demar and Adams do not alter any feature in their second games based on some action taken by the player such as the number of pay lines activated by a player. Moreover, as discussed above, Demar and Adams fail to disclose altering the changeable bonus award amounts displayed on a bonus selection apparatus. For these reasons, and because claim 30 depends from allowable claim 29, Applicant submits that claim 30 is allowable.

Like claim 30, dependent claim 31 depends from claim 29 and recites selection of a changeable bonus award amount to be displayed on a bonus selection apparatus based on the player's decisions in the base game. Specifically, claim 31 recites that the bonus award amount displayed on a bonus selection apparatus may be selected based on the amount that a player has wagered on at least one pay line. As argued in relation to claim 30, Demar and Adams fail to disclose changing a bonus award amount displayed on a bonus selection apparatus, let alone changing that bonus award amount based on the player's actions, such as the amount wagered on one or more pay lines. For these reasons, and because claim 31 depends from allowable claim 29, Applicant submits that claim 31 is allowable.

Dependent claims 32–36, 38, and 39 depend from claim 29 and recite the selection of a

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changeable bonus award amount for display on the bonus selection apparatus based on an outcome in the base game. Claims 33–36, 38, and 39 recite various outcomes that could form the basis for selection of a bonus award amount to be displayed and available for selection. Because Demar and Adams fail to disclose changing a bonus award amount under any conditions, let alone based on the outcome of a base game, and because claims 32–36, 38, and 39 depend from allowable claim 29, Applicant submits that claims 32–36, 38, and 39 are allowable.

Dependent claims 37 is substantially similar to claim 23. For the reasons advanced above with respect to claim 23, and because claim 37 depends from allowable claim 29, Applicant submits that claim 37 is allowable.

Dependent claims 40–44 are substantially similar to claims 24–28. For the reasons advanced above with respect to claims 24–28, and because claims 40–44 depend from allowable claim 29, Applicant submits that claims 40–44 are allowable.

Independent claim 45 is directed to a method of conducting a wagering game at a gaming machine and was discussed along with claims 19 and 29 above. For the reasons advanced above, Applicant submits that claim 45 is allowable.

Dependent claims 46 and 47 are substantially similar to claims 30 and 31, respectively. For the reasons advanced above with respect to claims 30 and 31, and because claims 46 and 47 depend from allowable claim 45, Applicant submits that claims 46 and 47 are allowable.

Dependent claims 48–52, 54, and 55 are substantially similar to claims 32–36, 38, and 39, respectively. For the reasons advanced above with respect to claims 32–36, 38, and 39, and because claims 48–52, 54, and 55 depend from allowable claim 45, Applicant submits that

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claims 48–52, 54, and 55 are allowable.

Dependent claim 53 is substantially similar to claim 37 above. For the reasons advanced above with respect to claim 37, and because claim 53 depends from allowable claim 45, Applicant submits that claim 53 is allowable.

Dependent claims 56–60 are substantially similar to claims 40–44 above. For the reasons advanced above with respect to claims 40–44, and because claims 56–60 depend from allowable claim 45, Applicant submits that claims 56–60 are allowable.

In sum, Applicant submits that the cited references fail to disclose the recited invention, namely a bonus selection apparatus that includes a changeable surface display element that dynamically changes the changeable bonus award amount displayed to a player. As such, Applicant respectfully submits that all claims are now in condition for allowance.

Conclusion

For the reasons advanced above, all pending claims are now believed to be in condition for allowance. Should Examiner believe that a telephone interview would advance the prosecution of this application, the undersigned would invite and request such an interview.

Respectfully submitted,
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